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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/466,947 12/20/99 PETERSON

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EXAMINER

QM12/1003

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ART UNIT

PAPER NUMBER

3732

DATE MAILED:

10/03/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/466,947

Applicant(s)
Peterson

Examiner
Ralph Lewis

Art Unit
3732



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2, 3
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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Rejections based on 35 U.S.C. 112, second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 22, line 1, there is no antecedent basis for "the method." It appears as though the claim should be dependent on claim 17.

Rejections Based on Prior Art

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

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Claims 1, 4, 6, 17-19 and 21-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Robertson et al (6,007,929).

Note Figure 2 illustrating an article body 10 (a pipe column 3, line 28, a dull black pipe column 1, line 39) having a painted white topcoat (note column 3, lines 18-30). The white paint top coat includes a nitrocellulose binder (column 5, line 30) which meets the broadly claimed "polymer coating." In regard to claims 6, 25 and 26, the statements as to what applicant intends for the marks to represent - species, genus - fail to provide for any structural distinction from the laser engraved marks disclosed by Robertson (only a single article has been claimed as opposed to a set - moreover, it is noted that the Robertson et al Figure 2 tag appears to suggest classifications).

Claims 1, 4, 6, 17-19 and 21-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee (5,446,338).

Lee discloses an article 21 having a contrasting colored polymeric coating 40 which is then laser engraved with indicia.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (5,446,338) in view of Nierenberg (4,323,755).

In regard to claims 2 and 3, the laser engraving of the Lee polymeric layer 40 apparently does not pass through to the article surface (See Figure 3). Nierenberg, however, at lines column 4, lines 22-26, teaches that the contrasting indicia may be made by vaporizing "through the coating." To have vaporized through the Lee coating as taught by Nierenberg would have been obvious to one of ordinary skill in the art.

In regard to claims 5, 13, 14, 29 and 30, Lee teaches that the adhesiveness of the polymeric coating is limited and the marker could fall off (note column 6, lines 9 and 10). It would have been obvious to have simply provided for a second marker or to have formed a less observable prior art marker in the work piece where it would not fall off as taught in Nierenberg so that one could readily identify the article if the Lee polymeric layer 40 came off. The limitations as to what applicant intends for the indicia on the label to represent fail to provide for any objectively ascertainable distinctions in the identification mark.

Claims 1-4, 6, 9, 15, 17-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hasegawa (4,323,317) in view of Kulper et al (5,626,966) and Roberston (5,855,969).

Hasegawa discloses a container 7 having a label 8 attached thereto upon which a laser forms indicia. Hasegawa does not disclose the composition of the label. Polymeric labels which are inscribed by lasers are well known in the art as evidenced by Kulper et al and Robertson. To

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have merely selected a prior art polymeric label for the label of Hasegawa would have been obvious to one of ordinary skill in the art. The selection of a label color that provides contrast with the article so that one can find and read the label - is simply obvious, conventional and well known as evidenced by a stroll through a supermarket

Claims 1, 4, 6, 16-19, 21-26 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horng et al (5,322,436) in view of Robertson et al (6,007,929).

Horng et al teaches engraving orthodontic bands with a laser mark, but does not disclose the claimed polymeric layer. Robertson et al, however, teaches that by providing a contrasting colored polymeric layer on a metal surface which is laser engraved provides for a more easily readable marking. To have provided Horng et al with a contrasting polymeric layer on which laser mark 14 is formed so as to increase visibility of the mark would have been obvious to one of ordinary skill in the art.

Claims 7, 8, 10-12, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hasegawa (4,323,317) in view of Kulper et al (5,626,966) and Roberston (5,855,969) as applied above and in further view of Grutzner (5,662,472).

Grutzner teaches the color coding of packages for dental materials. To have identified the Grutzner packages with labels as taught by Hasegawa so that one could readily ascertain their contents would have been obvious to one of ordinary skill in the art.

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Prior Art

Applicant's information disclosure statement of March 23, 2000 is incomplete. 37 CFR 1.98(b) requires identification of patentee, patent number and issue date. Accordingly, improperly listed references have not been considered. Copies of the information disclosure statements filed March 23, 2000 and November 30, 2000 with examiner initials are included herewith.

Kesling (4,120,090), Azuma et al (4,861,620), Arnold et al (5,893,714), Bernecker (5,958,528) and Hughes (6,169,266) are made of record.

Any inquiry concerning this communication should be directed to Ralph Lewis at telephone number (703) 308-0770. Fax (703) 872-9302.

R.Lewis
September 25, 2001


Ralph A. Lewis
Primary Examiner
Au3732